UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/002,433 | 10/23/2001 | Manoel Tenorio | 020431.0936 | 2605 |

53184        7590        11/27/2009
i2 TECHNOLOGIES US, INC.
11701 LUNA ROAD
DALLAS, TX 75234

| EXAMINER |
|---|
| THEIN, MARIA TERESA T |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3627 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/27/2009 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

candy_sanders@i2.com
steven@boothudall.com

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/002,433 | TENORIO, MANOEL |
| **Office Action Summary** | Examiner | Art Unit | |
| | MARISSA THEIN | 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>28 August 2009</u>.

2a) ☐ This action is **FINAL**.　　2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-35</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-35</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)　　　　　　　**Office Action Summary**　　　　　　　Part of Paper No./Mail Date 20091123

## DETAILED ACTION

### Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 28, 2009 has been entered.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,076,080 to Morscheck et al. in view of U.S. Patent No. 6,014,644 to Erickson.**

Regarding claims 1, 3-5, 11-13, 23-25 and 35, Morscheck discloses a system, method, and software comprising one or more repositories that stores a plurality of user documents used during a first electronic commerce transaction (File menu, order log, col. 9, lines 17-20); a search interface (Order Log search criteria window, col. 10, lines 7-27); a security module that decrypts the plurality of documents to allow a user to

access the plurality of documents (items may be disabled based on security access, col. 9, lines 21-22; col. 11, lines 36-37); and an intelligent module that updates one or more sections in the plurality of documents with current information associated with a second electronic commerce transaction (change order, col. 11, lines 32-55).

However, Morscheck does not explicitly disclose a global content directory which includes a plurality of classes; the documents comprise unique documents stored in seller database **(claim 3)**; classes comprise a plurality of document classes **(claims 4, 12, 24)**; the classes comprise a plurality of product classes **(claims 5, 13, 25)**. Morscheck does disclose a data menu (Figure 8) which includes commands to sort and find a data and show detail of an Order Log (col. 10, lines 61-66). Morscheck discloses a filter feature wherein the Order Log entries are filtered based on specific needs. The filter feature obtains a list of log entries based on some filtering criteria. (Col. 11, lines 2-11) Morscheck discloses the creation of an index of form design files which corresponds to the form design files stored in a first server and stores the index of form design files in the form design repository (col. 24, lines 23-28). Form design files correspond to a forms order (col. 24, lines 30-31). Furthermore, the graphic form design file is indexed in the forms design repository (col. 23, lines 21-23).

Erickson, on the other hand, teaches global content directory which includes a plurality of classes; the documents comprise unique documents stored in seller database **(claim 3)**; classes comprise a plurality of document classes **(claims 4, 12, 24)**; the classes comprise a plurality of product classes **(claims 5, 13, 25)** (col. 7, lines 14-17; col. 7, lines 50-52).

Examiner notes "Classification" is defined as "systematic arrangement in groups or categories according to established criteria". "Class" is defined as "rank"; "a group, set, or kind sharing common attributes"; and "a division or rating based on grade or quality". (Merriam Webster Collegiate Dictionary", Tenth Edition)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by Erickson, in order to allow easy access to the information stored (Erickson, col. 7, lines 16-17).

Regarding claims 2, 6-10, 14-22 and 26-34, Morscheck discloses the documents are stored in a shared document repository (Order Log, col. 9, lines 17-20) **(claim 2)**; the security module decrypts the user section in the user documents when the user documents as permission level (col.9, lines 21-22; col. 10, lines 61-64; col. 22, lines 58-62) **(claims 6, 18, 30)**; the intelligent module updates the sections in the user documents when the user requests the user documents to be updated (col. 11, lines 37-55) **(claim 7)**; the search interface allows the user to view user documents after the security module decrypts the user documents but before the intelligence updates the user documents with the current information associated with an associated transaction (col. 11, lines 13-29) **(claim 8)**; the intelligence module electronically creates one or more blank standard documents form the user documents (col. 15, line 65-col. 16, line

6) **(claims 9, 22 and 34)**; removes information from the sections of the user documents

and arranges the section in a particular order as a new document (col. 15, line 65-col.

16, line 6; col. 110, line 65-col. 111, line 13) **(claim 10)**; reissuing the user document

comprises automatically changing one or more sections in the document to include

current information (col. 15, line 65-col. 16, line 6; col. 110, line 65-col. 111, line 13)

**(claims 14, 26)**; reissuing the user documents comprises determining which section of

the user documents are generic and which sections are specific to a document

transactions, dynamically adjusting the generic sections; determining which sections

carry forward into one or more reissued user documents (col. 15, line 65-col. 16, line 6;

col. 110, line 65-col. 111, line 13) **(claims 15-17 and 27-29)**; view generic section and

the transaction specific sections of the user documents (col. 11, lines 13-29) **(claims**

**19, 31)**; searching for particular user documents' comprises navigating through the

document searching for  particular type of user documents (col. 11, lines 13-29) **(claims**

**20-21 and 32-33)**.

      However, Morscheck does not explicitly disclose document classes and product

classes. Morscheck discloses a filter feature wherein the Order Log entries are filtered

based on specific needs.  The filter feature obtains a list of log entries based on some

filtering criteria.  (Col. 11, lines 2-11)

      Erickson, on the other hand, teaches document classes and product classes (col.

7, lines 14-17; col. 7, lines 50-52).

      Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made the system, method and software of Morscheck, to

include global content directory which includes a plurality of classes; documents

comprise unique documents stored in seller database; classes comprise a plurality of

document classes; the classes comprise a plurality of product classes, as taught by

Erickson, in order to allow easy access to the information stored (Erickson, col. 7, lines

16-17).

### *Response to Arguments*

Applicant's arguments filed February 15, 2009 have been fully considered but

they are not persuasive.

Applicant remark that "Examiner fails to point to any specific disclosure of

Erickson or Morscheck that discloses this element and does not offer any assertion that

there is any suggestion to combine any of the teachings of Erickson and Morscheck to

suggest that "a plurality of classes organized in a hierarchy, each class categorizing the

plurality of documents and associated with one or more attributes of the plurality of

documents categorized in the class" would be obvious given the disclosures of these

two references, Applicant respectfully submits that a rejection under 35 U.S.C. § 103

cannot be properly maintained."

Examiner does not agree.  Morscheck discloses a data menu (Figure 8) which

includes commands to sort and find a data and show detail of an Order Log (col. 10,

lines 61-66). Morscheck discloses a filter feature wherein the Order Log entries are

filtered based on specific needs.  The filter feature obtains a list of log entries based on

some filtering criteria.  (Col. 11, lines 2-11)  Morscheck discloses the creation of an

index of form design files which corresponds to the form design files stored in a first

server and stores the index of form design files in the form design repository (col. 24,

lines 23-28). Form design files correspond to a forms order (col. 24, lines 30-31).

Furthermore, the graphic form design file is indexed in the forms design repository (col.

23, lines 21-23). Examiner notes that "index" is defined as "a list arranged usually in

alphabetical order of some specified datum" (Merriam Webster Collegiate Dictionary",

Tenth Edition, 1997) Moreover, the customer service representative (CSR) can retrieve

an existing or archived form order and modifies the existing order to meet the

requirements of a specific customer (col. 6, lines 20-24).

Such index of form design files which are stored in the form design repository are

considered plurality of documents stored in repository.

The Examiner then turns to Erickson to teach a plurality of classes organized in a

hierarchy, each class is categorized and associated with one or more attributes.

Erickson teaches a central database which is accessed via classifications or any other

manner that allows easy access by a buyer or supplier to the information stored in the

central database (col. 7, lines 14-17). The central database serves as a repository for

useful information to locate goods or services of interest (col. 7, lines 65-67).

Classification information may also be submitted illustrating types or classes or services

or goods provided by a particular company (col. 7, lines 50-52). Erickson teaches the

linking products and services to a class which will help locate groups or classes of

products or services available (col. 9, lines 47-49). "Classification" is defined as

"systematic arrangement in groups or categories according to established criteria".

"Class" is defined as "rank"; "a group, set, or kind sharing common attributes"; and "a

division or rating based on grade or quality". (Merriam Webster Collegiate Dictionary",

Tenth Edition, 1997)

Such central database of Erickson which is accessed via classification; central

database which serves as a repository for useful information to locate goods or services

of interest; classification information illustrates types or classes provided by a particular

company; linking products and services to a class which will help locate groups or

classes of products or services available; and definition of classification and class are

considered a plurality of classes organized in a hierarchy, each class is categorized and

associated with one or more attributes.

Applicant remarks that Examiner "failed to establish a Prima Facie case of

Obviousness over the proposed Morschek-Erickson Combination according to the

USPTO Examination Guidelines".

Morscheck was cited for teaching discloses a system, method, and software

comprising one or more repositories that stores a plurality of user documents used

during a first electronic commerce transaction; a search interface; a security module

that decrypts the plurality of documents to allow a user to access the plurality of

documents; and an intelligent module that updates one or more sections in the plurality

of documents with current information associated with a second electronic commerce

transaction a data menu which includes commands to sort and find a data and show

detail of an Order Log, as recited above. Morscheck discloses an order entry system

which includes a filter feature wherein the Order Log entries are filtered based on

specific needs.  The filter feature obtains a list of log entries based on some filtering

criteria.  (Col. 11, lines 2-11)  Furthermore, Morscheck discloses an option menu which

include commands such as change, reopen, accept, reject, price and place orders.  The

menu allows a user to enter or view a forms design request and make column settings

to the Order Log.  Some of these items may be disabled based on security access.

(Col. 11, lines 32-36)  Morscheck discloses the creation of an index of form design files

which corresponds to the form design files stored in a first server and stores the index of

form design files in the form design repository (col. 24, lines 23-28).  Form design files

correspond to a forms order (col. 24, lines 30-31).  Furthermore, the graphic form

design file is indexed in the forms design repository (col. 23, lines 21-23).  Examiner

notes that "index" is defined as "a list arranged usually in alphabetical order of some

specified datum" (Merriam Webster Collegiate Dictionary", Tenth Edition, 1997)

Moreover, the customer service representative (CSR) can retrieve an existing or

archived form order and modifies the existing order to meet the requirements of a

specific customer (col. 6, lines 20-24).  Such index of form design files which are stored

in the form design repository are considered plurality of documents stored in repository.

The Examiner then turns to Erickson to teach a plurality of classes organized in a

hierarchy, each class is categorized and associated with one or more attributes.

Erickson teaches a central database which is accessed via classifications or any other

manner that allows easy access by a buyer or supplier to the information stored in the

central database (col. 7, lines 14-17).  The central database serves as a repository for

useful information to locate goods or services of interest (col. 7, lines 65-67).

Classification information may also be submitted illustrating types or classes or services

or goods provided by a particular company (col. 7, lines 50-52). Erickson teaches the linking products and services to a class which will help locate groups or classes of products or services available (col. 9, lines 47-49). "Classification" is defined as "systematic arrangement in groups or categories according to established criteria". "Class" is defined as "rank"; "a group, set, or kind sharing common attributes"; and "a division or rating based on grade or quality". (Merriam Webster Collegiate Dictionary", Tenth Edition, 1997)

Such central database of Erickson which is accessed via classification; central database which serves as a repository for useful information to locate goods or services of interest; classification information illustrates types or classes provided by a particular company; linking products and services to a class which will help locate groups or classes of products or services available; and definition of classification and class are considered a plurality of classes organized in a hierarchy, each class is categorized and associated with one or more attributes.

Thus, it would have been obvious to one having ordinary skill in the art to use the classification in the central database taught by Erickson in the repository of Morschek, since the classification is no way dependent on the repository, and a classification could be used in combination with a standard repository to achieve the predictable result of allowing easy access to the information stored.

Examiner has relied on rationale (A). The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed

and the results of the combination are predictable.  When combined, the elements

perform the same function as they did separately. KSR, 82 USPQ2d 1385 (2007).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MARISSA THEIN whose telephone number is (571)272-

6764.  The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ryan Zeender can be reached on 571-272-6790.  The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marissa  Thein/
Examiner, Art Unit 3627
November 23, 2009